SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 786

WILCOX MANUFACTURING COMPANY, Petitioner,

v.

JEFFREY GALION MANUFACTURING COMPANY, Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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No valid reason exists for the granting of the requested writ.

The holding sought to be reviewed is not in conflict with the decisions of this Court. It is not in conflict with the law applied in other Circuits. Nor does it involve an issue of public importance. This is a conventional suit for patent infringement in which both the Court of Appeals and the District Court held the patents invalid on grounds thoroughly established by prior decisions of this Court and uniformly followed by all Courts of Appeals. Petitioner seeks review of the ultimate holding of the lower courts, but does not challenge the basis for that holding. Instead, petitioner has postulated a question for review which has no factual basis in the record

THE QUESTION PRESENTED.

Petitioner's statement of the question presented misstates the holding of the Court below. The lower courts did *not* hold the patents in suit invalid "on a technical point of Patent Office practice" (Petition, p. 3). Both courts held the patents invalid because the claims, in the scope urged by the patentee, were broader than any invention disclosed in the patent, hence, were not supported by the specification (App. 5a-6a, 24a-25a, 26a).

Thus, the sole question which can properly be presented on this record is whether a patent claim which is broader than the invention disclosed in the patent and which is not supported by the specification is invalid.

STATEMENT OF THE CASE.

Petitioner's "Statement of the Case" is factually accurate but woefully incomplete. The factual background presented in petitioners "Argument" is grossly inaccurate.

Petitioner was granted two patents. United States Letters Patent No. 2,967,701, issued January 10, 1961, purports to cover a method of mining. United States Letters Patent No. 3,026,098, issued March 20, 1962, purports to cover a mining machine. Both patents are based on a single application filed August 16, 1954.*

Shortly after issuance of the method patent, petitioner filed an ordinary infringement action against Eastern Gas and Fuel Associates, a customer of respondent, charging Eastern with infringement by reason of its use of a machine purchased from respondent and other machines made by Eastern. Promptly after the issuance of the apparatus patent, petitioner filed a supplemental complaint charging Eastern with infringement of the apparatus patent. Since a machine which respondent sold to Eastern was charged to infringe both patents, respondent agreed to take over the defense of the suit and filed a Declaratory Judgment action seeking a declaration that the patents were invalid and not infringed by respondent's machine. The two actions were consolidated for purposes of trial.

In a thorough opinion (App. 9a-27a) the District Court held the apparatus patent No. 3,026,098 invalid

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*Although both patents are in suit, petitioner has referred only to the apparatus patent No. 3,026,098 in its Petition.

on two independent grounds. First, the Court held the patent invalid because the subject matter thereof was obvious to those skilled in the art at the time the alleged invention was made (App. 24a, 26a). Second, the Court held that the patent was invalid for overclaiming because the claims, in the scope asserted, were broader than any invention disclosed in the patent or made by Mr. Wilcox (App. 24a-25a, 26a). The Court also pointed out that if a critical bit spacing existed, as petitioner from time to time asserted, the patent would be invalid for failure to give a clear and concise description of that critical bit spacing as required by 35 U.S.C. Section 112 (App. 25a).

The District Court stated that the foregoing holdings applied in large degree to the method patent. Additionally, it held the method patent invalid since it claimed merely the manner in which the apparatus is used (App. 25a). Finally, the Court held that neither respondent nor Eastern infringed either of the two patents (App. 26a, 27a).

The Court of Appeals for the Fourth Circuit affirmed the District Court. The Court of Appeals held that the claims of the apparatus patent were not supported by the specification, that they omitted an essential element (reciprocation) of the combination disclosed and, hence, were invalid; they overclaimed any possible invention (App. 5a-6a). Since the Court approved and affirmed the second ground on which the District Court held the patent invalid, it was unnecessary for the Court of Appeals to consider the other reason for the invalidity of the patent discussed by the District Court or the holding of non-infringement. Therefore, the Court did not

review the holding that the subject matter claimed was obvious to those skilled in the art. The Court of Appeals also noted that the asserted critical bit spacing was not defined or identifiable in the patent and, thus, consideration of that element was precluded by 35 U.S.C. Section 112. The Court of Appeals did point out that machines without the essential element (reciprocation) had been in public use more than a year prior to the first assertion by the patentee that a machine without that element was operable, as the District Court found (App. 23a-24a), and, therefore, claims not including that element also were invalid under 35 U.S.C. Section 102(b) because of the prior public use (App. 5a).

The Court of Appeals held the method patent invalid on the same ground that it held the apparatus patent invalid, namely, overclaiming (App. 8a). Further, the Court of Appeals, as did the District Court, held the patent invalid as a statement of how the machine is to be operated (App. 8a). Petitioner has not asserted error in the Court's decision regarding the method patent; therefore, respondent will not refer to it further.

ARGUMENT.

Although it is difficult to determine from the Petition the reason or reasons petitioner seeks review by this Court (other than petitioner's belief that the concurrent holdings of the lower Court are wrong), it appears from the "Conclusion" to be that the Court below decided a federal question in a way which is in conflict with the applicable decision of this Court (Petition, p. 14). Two conflicts are apparently asserted. First, petitioner claims the Court below erroneously applied the file wrapper estoppel doctrine contrary to the decisions of this Court. Second, petitioner asserts the Court below misapplied this Court's decisions in *Graham et al. v. John Deere Co.,* (1966) 383 U.S. 1 and *United States v. Adams et al.,* (1966) 383 U.S. 39. Neither contention is sound. There is no conflict with the decisions of this Court.

I.

The Court below did not "summarily 'vitiate' the Wilcox patent . . . on a highly technical point of Patent Office practice called file wrapper estoppel" (Petition, p. 4). It did not hold that "Wilcox was estopped to reinstate the combination claims without the reciprocation feature"; and, it did not invalidate the patent "erroneously relying on file wrapper estoppel" (Petition, p. 12). The Court of Appeals did not refer to or rely on any estoppel, file wrapper or otherwise, in its holding. Petitioner's reference to file wrapper estoppel is a ruse to hide the true basis for the decisions of the lower Courts and to create a basis for review of those decisions by this Court.

The actual basis for the decision was succinctly stated by the Court of Appeals, namely, "the patent is void because the claims *lack support in the specifications*"* (App. 5a). The District Court similarly clearly stated the basis for its holding — the claims are invalid "for overclaiming by purporting to cover a combination *not disclosed in the patent*" (App. 25a). The patent code, 35 U.S.C. Section 112, requires that the "specification shall contain a written description of the invention . . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . . to make and use the same."** This Court has repeatedly held patent claims invalid when they are not supported by the specification, i.e., when the invention claimed is not disclosed by the specification. In *Permutit Co. v. Graver Corporation,* (1931) 284 U.S. 52, 57, this Court held the patent in suit "invalid for lack of the disclosure prescribed by R.S. § 4888."*** This Court pointed out that there was "no mention in the specification of either a 'free' or a 'locked' zeolite bed; or the alleged discovery that a rising space above the zeolite bed is necessary for the successful operation of the softener." Similarly, in this case there was no mention in the specification of a workable machine without reciprocation. The District Court held that the

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*Emphasis ours throughout unless otherwise noted.

**This requirement should not be confused with the further requirement of 35 U.S.C. Section 112 that they must also include "the best mode contemplated by the inventor of carrying out his invention." These are two separate requirements.

***R.S. § 4888 was embodied in 35 U.S.C. Section 112 when the patent laws were codified in 1952.

"patent specifically discloses a machine in which reciprocation is a *vital* element" (App. 24a); and the Court of Appeals held that it was "the predominant predicate of the Wilcox application" (App. 5a).

In *Schriber-Schroth Co. v. Cleveland Trust Co. et al.,* (1938) 305 U.S. 47, this Court considered the function of the specification and stated (p. 57):

> "It follows that the patent monopoly does not extend beycnd the invention described and explained as the statute requires, *Permutit Co. v. Graver Corporation, supra,* at 57; that *it cannot be enlarged by claims in the patent not supported by the description, Snow v. Lake Shore & M. S. Ry. Co.,* 121 U.S. 617; cf. *Smith v. Snow,* 294 U.S. 1; and that the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened. *Railway Co. v. Sayles,* 97 U.S. 554, 563, 564; *Powers-Kennedy Corp. v. Concrete Co.,* 282 U.S. 175, 185-186; cf. *Webster Electric Co. v. Splitdorf Electrical Co.,* 264 U.S. 463; *Permutit Co. v. Graver Corporation, supra; Crown Cork & Seal Co. v. Gutmann Co.,* 304 U.S. 159."

And in *Graver Tank & Mfg. Co., Inc. et al. v. Linde Air Products Co.,* (1949) 336 U.S. 271, 277, this Court held claims invalid because they were too broad and were not limited to the invention taught by the specification, stating:

> "While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their

> function as a measure of the grant *when they overclaim the invention.* When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. *Cf. General Electric Co. v. Wabash Co.,* 304 U.S. 364, 373-374; see *McClain v. Ortmayer,* 141 U.S. 419, 424-425; *Cimiotti Unhairing Co. v. American Fur Refining Co.,* 198 U.S. 399, 410."

Both the District Court and the Court of Appeals relied upon and correctly applied the law as stated in those decisions of this Court. The patents in suit were held invalid because the claims were broader than the invention taught by the specification. As stated by the District Court "any attempt to construe the claims in a manner which does not require reciprocation or its equivalent renders them invalid for overclaiming by purporting to cover a combination not disclosed in the patent" (App. 25a).

Neither Court held the patent invalid because of file wrapper estoppel. Reference was made to the file history, as stated by the Court of Appeals, solely for the purpose of assisting in a determination of the nature of the invention (App. 7a). This Court authorized and required such reference in the *Graham* case, *supra,* at page 33, where it stated that "an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office."

Petitioner's argument that the Court of Appeals erroneously applied the doctrine of file wrapper estoppel misstates the holdings below.

II.

Petitioner apparently asserts that the Court of Appeals erred in not passing on the obviousness of the alleged invention and, in so doing, "did not heed the commands of" the *Graham* case, *supra* (Petition, p. 13). There is no substance in this assertion. The *Graham* and the *Adams* cases, *supra,* both relate solely to the question of obviousness and interpretation of 35 U.S.C. Section 103. The Court of Appeals had no occasion, as it expressly observed, to consider the question of obviousness since the patent was invalid for failure to comply with the requirements of 35 U.S.C., Section 112. To consider the obviousness of an alleged invention when the patent is patently invalid for failure to comply with the requirements of 35 U.S.C., Section 112 would be superfluous. The course followed by the Court of Appeals was the same course followed by this Court in *Permutit Co. v. Graver Corporation, supra, stated above.* This Court held the patent there under consideration invalid for failure to comply with R.S., Section 4888, the precedent of 35 U.S.C., Section 112 and stated in so holding "We have no occasion to consider whether this alleged Gans invention of a 'free' zeolite bed rises to the dignity of invention or whether, as Graver Corporation contends, it lacked novelty, and was anticipated by earlier apparatus and publications." Thus, this Court, after determining the patent was invalid for an inadequate specification, did not consider the superfluous question of invention or obviousness. The Court of Appeals followed this course and found "no occasion to put it [the claimed invention] to the obviousness tests of Graham v. John Deere Co" (App. 7a). This is clearly the proper course. It should also be pointed out that the District

Court did, in fact, pass on the obviousness of the alleged invention and specifically held that "the subject matter thereof was obvious to those skilled in the art at the time the alleged invention was made" (App. 26a).

CONCLUSION.

We submit that the petition for a writ of *certiorari* should be denied.

Respectfully submitted,

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